

U.S. PATENT APPLICATION 09/785,417
DOCKET NO. 11995/1

That is to say, there is no dispute that Tanaka does not teach the adoption of the values disclosed by Nakamigawa and Nakamigawa does not teach the adoption of the values disclosed by Tanaka. What is also clear is that there is suggestion in the prior art to combine the values disclosed by Tanaka and Nakamigawa. A skilled person would carefully consider whether a particular head would fit well with a particular medium before deciding on values such as Tb1, and he would never adopt values designed for disparate purposes. It is only from the teaching of Applicants' specification that one finds any suggestion of combination. Without this, the alleged suggestion noted by the Examiner does not exist. The type of hindsight reconstruction engaged in by the Examiner, using Applicants specification to find a reason to combine the features of the references has long been recognized as improper.

Absent Applicants' teaching, the combining of these features is analogous to finding it obvious to construct a vehicle with a dump truck body and tires from a light car, just because both elements are known. In almost any combination invention, the individual elements making up the combination are known. That is why more than just collecting elements from the prior art is necessary.

In summary, there are significant differences between each of the cited references and what is claimed. Individual elements of the claims are found in these references, but Applicants do not believe the Examiner has met his burden of showing the motivation, which one would need reach the claimed invention. Thus, all claims are now in condition for allowance, prompt notice of which is respectfully solicited.

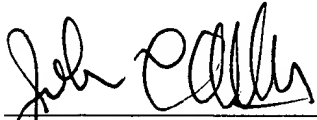
The Examiner is invited to call the undersigned at (202) 220-4200 to discuss any information concerning this application.

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The Office is hereby authorized to charge any fees under 37 C.F.R. § 1.16 or § 1.17 or credit any overpayment to Deposit Account No. 11-0600.

Respectfully submitted,

Date: January 8, 2003



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